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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/780,002	02/17/2004	Daniel F. Klessig	3670-P02652US01	9555

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EXAMINER

IBRAHIM, MEDINA AHMED

ART UNIT PAPER NUMBER

1638

DATE MAILED: 09/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action  
Before the Filing of an Appeal Brief**

Application No.

10/780,002

Applicant(s)

KLESSIG ET AL.

Examiner

Medina A. Ibrahim

Art Unit

1638

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 23 August 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☒ Applicant's reply has overcome the following rejection(s): the 102 rejection to claims 1, 4-9, 24 and 27-30.  
6. ☒ Newly proposed or amended claim(s) 2, 3, 25 and 31 would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: 2, 3, 25 and 31.  
Claim(s) rejected: 1, 4-9, 24, 26-30, 32, 44 and 50.  
Claim(s) withdrawn from consideration: 10-20, 22, 23, 33-43 and 46-49.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_.  
13. ☒ Other: See Continuation Sheet.

Continuation of 11. does NOT place the application in condition for allowance because: claims that recite SEQ ID NO: 36 lack written description for the reasons of record. The specification only states that SEQ ID NO: 36 is a homolog of the disclosed tobacco SABP2. However, whether SEQ ID NO: 36 has SABP2 function is unknown. Claim 27 remains rejected under 112, 2nd paragraph because the claim recites two unrelated methods in a single claim. Claim 24 is directed to overexpressing SABP2 nucleic acid in a transgenic plant; claim 27 further recites steps of introducing the SABP2 nucleic acid into a host cell, treating the host cell with an agent, and assaying SABP2 function in the host cell or extracts thereof. Therefore, the combination of two unrelated methods in a single claim creates confusion. See In Ex parte Lyell, 17 USPQ2d 1548 (Bd. Pat. App. & Inter. 1990).

Continuation of 13. Other: The attached Examiner's amendment which would place the claims in condition for allowance was faxed to Applicant on 08/29/06; however Applicant didn't approve all the amendments.

#### In The Claims:

Claim 1 (Currently amended). An isolated SABP2 nucleic acid molecule comprising a nucleotide sequence selected from the group consisting of:

- a) the nucleotide sequence of SEQ ID NO: 2; and
- b) a nucleotide sequence encoding the polypeptide of SEQ ID NO: 2; [and
- d) a homolog having a sequence of SEQ ID NO: 36.]

At claim 3, ---nucleotide--- is inserted before "sequence".

Claim 4 (Currently amended). [A cDNA produced by reverse transcription of an mRNA encoded by the] The isolated nucleic acid molecule of claim 1, which is a DNA molecule.

Claim 8 (Currently amended). A [The] host cell transformed with the [an] expression vector of claim 6.

Claim 9 (Currently amended). The [A] host cell of claim 8, wherein said host cell is selected from the group consisting of a plant cell [tobacco, Arabidopsis, rice, maize, wheat, soybean, tomato, potato, barley, canola,] bacterial cell, yeast cell, and insect cell [and mammalian cells].

Claims 10-20 and 22-23 are cancelled.

Claim 24 (Currently amended). A method for enhancing [to enhance] resistance of a plant to a plant pathogen[s or other disease causing agents] comprising [overexpressing an SABP2] transforming the plant with the nucleic acid molecule of claim 1 [in a plant cell of said plant, wherein said overexpression of said SABP2 nucleic acid molecule enhances the resistance of said plant to plant pathogens or other disease causing agents].

Claim 26 (Currently amended). The method of claim 24, wherein the [homolog comprises the] nucleic acid molecule encodes [of] SEQ ID NO: 2 [36].

Claim 27 is cancelled.

At claim 28, ---isolated--- is inserted before "nucleic".

At claim 29, "fertile" is replaced with ---tobacco---.

Claim 32 (Currently amended). The transgenic plant of claim 28, wherein [said homolog comprises] the nucleic acid molecule encodes [sequence of] SEQ ID NO: 2 [36].

Claims 33-43 are cancelled.

Claim 44 (Currently amended). The method of claim 24, wherein said [overexpression of said SABP2] nucleic acid molecule is overexpressed in said plant, and wherein said overexpression enhances the resistance of said plant to a plant pathogen [comprises transforming the plant cells of said plant with said nucleic acid molecule of claim 1].

Claims 45-50 are cancelled.

Claim 51(New). The host cell of claim 8, wherein said plant cell is from a plant selected from the group consisting of tobacco, Arabidopsis, rice, maize, wheat, soybean, tomato, potato, barley, and canola.

#### Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Medina A. Ibrahim whose telephone number is (571) 272-0797. The Examiner can normally be reached Monday -Thursday from 8:00AM to 5:30PM and every other Friday from 9:00AM to 5:00 PM . Before and after final responses should be directed to fax nos. (703) 872-9306 and (703) 872-9307, respectively.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Anne Marie Grunberg, can be reached at (571) 272-0975.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

9/06/06

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MEDINA A. IBRAHIM  
PRIMARY EXAMINER

